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Appellants' Brief on Appeal
U.S. Application Serial No. 10/674,353

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Kenichiro YASUI, et al.

Serial No.: 10/674,353

Group Art Unit: 2835

Filed: October 1, 2003

Examiner: Chang, Yean Hsi

For: FOLDABLE HANDY ELECTRONIC DEVICE

AMENDED APPELLANTS' BRIEF ON APPEAL

Honorable Commissioner of Patents
Alexandria, Virginia 22313-1450
Box AF

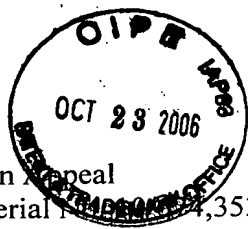
Sir:

Further to the Appeal Brief filed on July 10, 2006, and in response to the Notification of Non-Compliant Appeal Brief dated September 22, 2006, Appellants submit an Amended Appellants' Brief on Appeal.

Appellants respectfully appeal the final rejection of claims 1, 2, 13-16 and 19 in the Final Office Action dated November 7, 2005. A Notice of Appeal was timely filed on May 8, 2006, with a Petition for an Extension of Time and a corresponding extension of time fee.

I. REAL PARTY IN INTEREST

The real party in interest is NEC Corporation, assignee of 100% interest of the above-referenced patent application.



II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or Assignee, which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-20, all of the claims in the Application, are set forth fully in the attached Appendix.

Claims 3-12 and 20 have been allowed by the Examiner.

Claims 17 and 18 stand objected to for depending from a rejected claim but would be allowable if rewritten in independent form.

Claims 1, 2, 13-16 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Murray, et al. (U.S. Patent No. 6,011,699) (hereinafter "Murray").

Appellants respectfully appeal the rejections of claims 1, 2, 13-16 and 19 under 35 U.S.C. § 102(b) as being anticipated by Murray, et al. (U.S. Patent No. 6,011,699; hereinafter "Murray"), which is the sole issue in this Appeal.

IV. STATUS OF AMENDMENTS

An Amendment under 37 C.F.R. § 1.116 was filed on January 6, 2006. Appellants incorporated the subject matter of claim 13 into independent claims 1 and 19. Additionally, Appellants amended allowable claims 17 and 18 into independent form, in accordance with the Examiner's indication of allowability. In the Advisory Action dated January 26, 2006, however, the Examiner indicated that the Amendment filed on January 6, 2006 was not

entered. Therefore, the claims in the Appendix reflect the version of the claims in the Amendment under 37 C.F.R. § 1.111 submitted on October 13, 2005.

A Notice of Appeal was timely filed on May 8, 2006, with a Petition for an Extension of Time and corresponding extension of time fee.

Therefore, the claims are pending as set forth in the Appendix.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention of exemplary claim 1 (and similarly claim 19) is directed to a foldable electronic device. The electronic device includes a first body having a display covered by a screen and a second body having an interface through which a user can operate the electronic device. The first body and the second body are rotatable to each other through a hinge. The first body has a first surface facing the second body when the electronic device is folded. The second body has a second surface facing the first body when the electronic device is folded. The interface projects by a height from the second surface. The first body includes a recess with the first surface. The recess aligns with the interface when the electronic device is folded, and has a depth equal to or greater than said height. The display and the screen are located within the recess.

The claimed invention of exemplary claim 13 is directed to a foldable electronic device wherein the recess extends along an entire length of the interface.

The non-obvious and unique combination of features provides a foldable electronic device wherein the display and the interface are sufficiently spaced apart to avoid interference with each other while continuing to enable a user to sufficiently compress operation keys to operate the electronic device (see Application at page 4, lines 6-10).

Referring to the exemplary embodiments of the invention depicted in Figure 3, a foldable electronic device includes a first body (e.g., 1; see Application at page 7, lines 17-18) having a display (e.g., 3; see Application at page 7, line 28) covered by a screen (e.g., 5; see Application at page 7, line 28) and a second body (e.g., 2; see Application at page 7, lines 17-18) having an interface (e.g., 6; see Application at page 8, line 5) through which a user can operate the electronic device. The first body (e.g., 1) and the second body (e.g., 2) are rotatable to each other through a hinge (e.g., 105) (e.g., see Application at page 7, lines 18-21). The first body (e.g., 1) has a first surface (e.g., see Application at page 7, lines 22-27) facing the second body (e.g., 2) when the electronic device is folded. The second body (e.g., 2) has a second surface facing the first body (e.g., 1) when the electronic device is folded (e.g., see Application at page 7, lines 22-27). The interface (e.g., 6) projects by a height from the second surface (e.g., see Application at Figure 3). The first body (e.g., 1) includes a recess (e.g., 4; see Application at page 8, line 15) with the first surface. The recess (e.g., 4) aligns with the interface (e.g., 6) when the electronic device is folded, and has a depth equal to or greater than said height. The display (e.g., 3) and the screen (e.g., 5) are located within the recess (e.g., 4) (e.g., see Application at page 8, lines 13-26 and Figure 4).

The claimed invention of exemplary claim 13 is directed to a foldable electronic device wherein the recess (e.g., 4; see Application at page 8, lines 13-18) extends along an entire length of the interface (e.g., 6) (e.g., see Figure 3).

As mentioned above, the non-obvious and unique combination of features provides a foldable electronic device wherein the display and the interface are sufficiently spaced apart to avoid interference with each other while continuing to enable a user to sufficiently

compress operation keys to operate the electronic device (see Application at page 4, lines 6-10).

Each of the features recited in dependent claims 2 and 14-16 are described in detail in the Specification (e.g., see pages 7-14) and Figures 3-9 of the Application.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review by the Board of Patent Appeals and Interferences are whether independent claims 1 and 19, and dependent 2 and 13-16 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Murray.

VII. ARGUMENT

A. THE EXAMINER'S POSITION

In the Final Office Action mailed November 7, 2005, the Examiner rejected claims 1, 2, 13-16 and 19 under 35 U.S.C. § 102(b) as being anticipated by Murray.

The Examiner alleged that Murray disclosed a *“first body comprising a recess (between 352 and 354 in fig. 4) with said first surface, said recess aligning with said interface when said electronic device is folded (shown in figs. 1 and 11), and having a depth equal to or greater than said height (shown in fig. 11), and said display and said screen being located with said recess (shown in figs. 5-6 and 11)”* (see Office Action mailed November 7, 2005, at page 2). The Examiner further alleged, that Murray disclosed, *“wherein said recess extends along an entire length of said interface (shown in fig. 11)”* (see Office Action dated November 7, 2005 at page 3).

B. APPELLANTS' POSITION

To summarize, Appellants submit that the Examiner's position is flawed as a matter of fact and law. Thus, claims 1, 2 13-16 and 19 are not anticipated by Murray.

i) Independent claims 1 and 19 (as well as claims 2 and 13-16, which depend therefrom) are not anticipated by Murray under 35 U.S.C. § 102(b).

1. INDEPENDENT CLAIMS 1 and 19

a. The Examiner's Position is Flawed as a Matter of Fact and Law.

The Examiner alleged that Murray teaches the claimed invention of claims 1, 2, 13-16 and 19. Appellants submit, however, that there are features of the claimed invention that are neither taught nor suggested by the claimed invention.

Appellants respectfully submit that the Examiner's position is flawed as a matter of fact and law because the Examiner has mischaracterized the teachings of Murray and the Examiner has not established that Murray anticipates the claimed invention.

Appellants point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (see M.P.E.P. § 2131; emphasis added by Appellants). The Examiner has failed to establish that Murray anticipates the claimed invention.

That is, Murray does not teach or suggest "*said display and said screen being located within said recess*" (emphasis added by Appellants) as recited in claim 1 (and similarly recited in claim 19).

The Examiner relies on features from Figures 1, 4, 7 and 11 of Murray to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in these figures (nor anywhere else for that matter) does Murray teach or suggest that the display and the screen are located within the recess.

The claimed invention, as exemplarily depicted in Figure 4 of the Application, provides a recess (e.g., 4), wherein the screen (e.g., 5) and the display (e.g., 3) are located within the recess (e.g., 4). This allows the screen (e.g., 5) and the display (e.g., 3) of the portable electronic device to be protected from contact with the interface (e.g., 6) when the electronic device is in a closed position.

In stark contrast, however, Murray merely teaches that the display (346) is fitted in a recess (see Murray at Figure 11). The lens (204), which covers the display (346), is not disposed inside of the recess and is not separated from the operation keys (1110) by the recess.

Therefore, the claimed invention of claims 1 and 19 (as well as claims 2 and 13-16, which depend therefrom) is not anticipated by Murray.

Therefore, Appellants respectfully submit that the Examiner's position is clearly unreasonable.

2. DEPENDENT CLAIM 2 and 13-16

a. The Examiner's Position is Flawed as a Matter of Fact and Law.

Claim 2 depends from claim 1 and recites "*wherein said electronic device comprises a cellular phone*". This feature is not taught or suggested by Murray.

Therefore, dependent claim 2, like independent claims 1 and 19, includes at least one element, which is not taught or suggested by the cited prior art references, nor any combination of the cited references.

Claim 13 depends from claim 6 (and similarly claim 20, which depends from claim 18) and recites “*wherein said recess extends along an entire length of said interface*”. This feature is not taught or suggested by Murray.

The Examiner relies on features from Figures 1, 4, 7 and 11 of Murray to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in these figures (nor anywhere else for that matter) does Murray teach or suggest that the recess extends along an entire length of the interface. Indeed, the recess, in Murray, only extends along a portion of the interface.

Indeed, as shown in Figure 11 of Murray, the recess extends along a portion of the interface where the lens (204) is disposed. That is, the recess merely extends from a first end to a second end of the lens (204), as is clearly depicted in Figure 11. However, interface keys (1110) are positioned beyond the lens (204), and, therefore, extend beyond the recess. Thus, the recess in Murray clearly does not extend along an entire length of the interface.

In stark contrast, the claimed invention provides a recess (e.g., 4) that extends along the entire length of the interface (e.g., 6). That is, none of the operation keys (e.g., 7), which are provided in the interface (e.g., 6), are positioned outside of the recess (e.g., 4), as in the device of Murray (e.g., see Application at Figure 4).

Therefore, dependent claim 13, like independent claims 1 and 19, includes at least one element, which is not taught or suggested by the cited prior art references, nor any combination of the cited references.

Claim 14 depends from claim 1 and recites "*wherein said interface comprises a plurality of operation keys*". This feature is not taught or suggested by Murray.

Therefore, dependent claim 14, like independent claims 1 and 19, includes at least one element, which is not taught or suggested by the cited prior art references, nor any combination of the cited references.

Claim 15 depends from claim 1 and recites "*wherein said operation keys are received into said recess when said electronic device is folded to reduce a space between said first body and said second body*". This feature is not taught or suggested by Murray.

Therefore, dependent claim 15, like independent claims 1 and 19, includes at least one element, which is not taught or suggested by the cited prior art references, nor any combination of the cited references.

Claim 16 depends from claim 1 and recites "*wherein said first body comprises at least one second recess*". This feature is not taught or suggested by Murray.

Therefore, dependent claim 16, like independent claims 1 and 19, includes at least one element, which is not taught or suggested by the cited prior art references, nor any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

VIII. CONCLUSION

In view of the foregoing, Appellants submit that claims 1-20, all of the claims presently pending in the application, are patentably distinct from the prior art of record and in

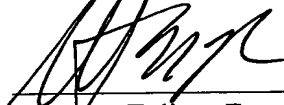
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condition for allowance. Thus, the Board is respectfully requested to remove the rejections of claims 1, 2, 13-16 and 19.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Attorney's Deposit Account number 50-0481.

Date: October 23, 2006

Respectfully Submitted,



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 21254

CLAIMS APPENDIX

1. A foldable electronic device including a first body having a display covered by a screen and a second body having an interface through which a user can operate said electronic device,

said first body and said second body being rotatable to each other through a hinge,

said first body having a first surface facing said second body when said electronic device is folded, said second body having a second surface facing said first body when said electronic device is folded,

said interface projecting by a height from said second surface,

said first body comprising a recess with said first surface, said recess aligning with said interface when said electronic device is folded, and having a depth equal to or greater than said height, and

said display and said screen being located within said recess.
2. The foldable electronic device as set forth in claim 1, wherein said electronic device comprises a cellular phone.
13. The foldable electronic device according to claim 1, wherein said recess extends along an entire length of said interface.
14. The foldable electronic device according to claim 1, wherein said interface comprises a plurality of operation keys.

15. The foldable electronic device according to claim 14, wherein said operation keys are received into said recess when said electronic device is folded to reduce a space between said first body and said second body.

16. The foldable electronic device according to claim 1, wherein said first body comprises at least one second recess.

19. A foldable electronic device including a first body having a display and a second body having an interface through which a user can operate said electronic device,

said first body and said second body being rotatable to each other through a hinge,

said first body having a first surface facing said second body when said electronic device is folded, said second body having a second surface facing said first body when said electronic device is folded,

said interface comprising a plurality of operation keys projecting by a height from said second surface,

said first body comprising a recess with said first surface, said recess aligning with said interface when said electronic device is folded, and having a depth equal to or greater than said height, said operation keys being received into said recess when said electronic device is folded to reduce a space between said first body and said second body and

said display and said screen being located within said recess.

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EVIDENCE APPENDIX

Not applicable.

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RELATED PROCEEDINGS APPENDIX

Not applicable.